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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/075,722 | 02/14/2002 | Luke David Jagger | NETAP022 | 1628 |
| 28875 | 7590 | 10/03/2005 | EXAMINER | |
| Zilka-Kotab, PC P.O. BOX 721120 SAN JOSE, CA 95172-1120 | | | BLACKWELL, JAMES H | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2176 | |

DATE MAILED: 10/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/075,722

Applicant(s)

JAGGER ET AL.

Examiner

James H. Blackwell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 8-25 is/are pending in the application.
- 4a) Of the above claim(s) 25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 8-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

AT

DETAILED ACTION

1. This Office Action is in response to an amendment filed 07/07/2005.
2. Claims 1-5, and 8-24 remain pending. Claims 1, 13, and 18 are independent claims. Claims 6-7 were previously cancelled, and Claim 25 has been newly cancelled in this amendment.
3. The rejections of Claims 4, 16, 21, and 23 under 35 U.S.C. §112 2nd paragraph have been withdrawn based on an explanation provided by applicant.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3, 5, 8-15, 17-18, 20, and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Ralston et al. (hereinafter Ralston, U.S. Patent No. 6,842,773).

In regard to independent Claim 1 (and similarly independent claims 13, and 18), Ralston teaches a process for generating a signature (checksum) of an email based only on the body of the message (the phrase body of the message is interpreted as that part of the message that contains the actual message). The process begins in step 704 where an e-mail message (400) is retrieved. The received email message is "filtered" to remove the *headers* or other so-called hidden information (e.g., *end-of-line*

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characters, control characters, etc.) leaving behind the visible body (408) of the message (400) in step 708. Generally, the motivation behind removing such information is to avoid confusion in further processing of the message (Col. 14, lines 10-20). Such future processing can involve comparing a "fingerprint" of the message to a database of known unsolicited email fingerprints (Col. 13, lines 7-14).

Ralston also teaches that an email message can be broken down by finding one or more anchors in the visible text portions of the body of the email (Col. 6, lines 2-3). Such anchors are then treated as representative of the particular email and are then compared with a database for possible identification as being unsolicited (Col. 6, lines 4-16). It is noted that Ralston both performs a certain amount of filtering of the email message and also only generates anchors (checksums) from within the body of the email message (excluding headers, footers, and other characters or non-characters that would be detrimental to the determination of whether the email is solicited or unsolicited). It is further noted that regardless of whether or not components, most notably the headers, are physically removed or are not included in the generation of a checksum or other identifier that the result is the same. Namely, the exclusion of components that would act as a source of potential confusion in the identification of unsolicited email. Thus, Ralston teaches *generating a checksum based on data remaining within the electronic mail message and comparing the generated checksum with a database containing checksums for previously identified unsolicited messages.*

Ralston also teaches *identifying the electronic message as an unsolicited message if the generated checksum matches one of the database checksums* (e.g., Col. 5, lines 52-65).

Ralston also teaches that an unsolicited mailer is a party that sends email indiscriminately to thousands and possibly millions of unsuspecting users in a short period of time (Col. 3, lines 22-31). It is well known in the art that another term used to describe such parties is spammers.

In regard to dependent Claim 2 (and similarly dependent Claims 3, 14-15, and 20), Ralston teaches a number of different scenarios for generating “fingerprints” or codes, or exemplars on the visible body of the email (e.g., Figs. 7a-d). In each case, individual checksums or fingerprints are identified (anchors) and generated (Col. 6, lines 2-17; Col. 12, lines 63-67; Col. 13-14; Col. 15, lines 1-28). Thus, Ralston teaches *generating a checksum comprises generating individual checksums for portions of the remaining data.*

In regard to dependent Claim 5, Ralston teaches *removing forwarding information* in that the received email message is “filtered” to remove the *headers* or other so-called hidden information (e.g., *end-of-line characters, control characters, etc.*) *leaving behind the visible body (408) of the message (400) in step 708*. Generally, the motivation behind removing such information is to avoid confusion in further processing of the message (Col. 14, lines 10-20). It is noted that such forwarding information is typically contained in the headers of the email message, which is removed.

In regard to dependent Claim 8, Ralston teaches *deleting the electronic mail message if the message is identified as an unsolicited message* in that electronic mail messages that are found to be bulk electronic mail messages are removed or discarded from the solicited email folder into a suspected bulk email folder (see Figs. 5a-f).

In regard to dependent Claim 9, Ralston teaches *at least temporarily storing the electronic message if the message is identified as an unsolicited message* (Figs. 5a-f, suspect emails are stored in bulk email folders).

In regard to dependent Claim 10, Ralston teaches *forwarding the electronic message to an intended recipient if the message is not identified as an unsolicited message* (see Figs. 5a-f, if not suspected as being unsolicited, email is placed into inbox and sorted).

In regard to dependent Claim 11, Ralston teaches *updating the database with new checksums* in that the message database (206) stores fingerprints for messages received by the mail system (112). Acting as a server, the message database (206) provides fingerprint information to the mail transfer agent (204) during processing of an e-mail message. Each message is processed to generate a fingerprint representative of the message. If a fingerprint matches one in the message database (206), the message may be sorted into the bulk mail folder of the user. *Any message unique to the mail system has its fingerprint stored in the message database (206) to allow for matching to subsequent messages.* In this way, patterns can be uncovered in the messages received by the mail system (112).

In regard to dependent Claims 12, and 17, Claims 12, and 17 contain similar subject matter as that found in Claim 11, and are rejected along similar lines of reasoning.

In regard to dependent Claim 22, Ralston does not explicitly teach that *the forwarding information includes a ">" character*. However, it is notoriously well known to one of ordinary skill in the art of electronic mail to know that forwarded information is commonly designated by prefixing each line with a right caret (">") character.

In regard to dependent Claim 24, Claim 24 contains similar subject matter to that found in Claim 1 (and similarly Claims 13, and 18), and is rejected along the same rationale.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 4, 16, 19, and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ralston.

In regard to dependent Claim 4 (and similarly dependent Claims 16, 21, and 23), Ralston fails to teach *comparing a checksum comprises comparing checksums starting with one of the portions at the end of the remaining data and working backwards through the data*. However, it is notoriously well known in the art to make

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comparisons between items in any order. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to compare checksums in either direction (top to bottom, or bottom to top) providing the benefit of identifying unsolicited emails.

In regard to dependent Claim 19, Ralston does not explicitly teach that *the computer readable medium is selected from the group consisting of CD-ROM, floppy disk, tape, flash memory, system memory, and hard drive*. However, Ralston does teach the use of a number of databases, implying the use of one or more of the storage media claimed. Thus, it would have been obvious to one of ordinary skill in the art at the time of invention to conclude that Ralston would have made use of one or more of the claimed computer readable media, providing the benefit of storing fingerprints of email messages.

Response to Arguments

8. Applicant's arguments with respect to claims 1-5, and 8-24 have been considered but are moot in view of the new ground(s) of rejection. It is respectfully noted that with respect to the Applicant's argument that the prior art fails to teach the limitations of Claim 4 (and similarly Claims 16, 21, and 23), that the sequence of events implied by the claim limitations is confusing as the motivation for the particular method of comparing checksums from the "bottom up" stated in the Specification (see Pg. 11, lines 14-19) seems moot in light of the prior removal of non-static material such as the header (see Pg. 11, lines 1-3). The rationale for starting from the bottom up rather than from the top down does not make sense if one is simply trying to avoid getting confused with header information, that according to the specification has been removed.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H. Blackwell whose telephone number is 571-272-4089. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R. Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James H. Blackwell
09/28/05

William L Bashore
WILLIAM BASHORE
PRIMARY EXAMINER
9/28/2005